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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/068,278 07/09/98 LOCHER

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QM12/0913

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EXAMINER

CADUGAN, E

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 09/13/01

*21*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Advisory Action**

Application No.

09/068,278

Applicant(s)

LOCHER ET AL.

Examiner

Erica E Cadugan

Art Unit

3722

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 August 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 27 August 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 39-49, 75-82, 84-85, 87-90, 100-113, 115-118, 120-123, 125

Claim(s) withdrawn from consideration: 50-74, 83, 86, 91-99, 114, 119, 124, 126-130

8. ☒ The proposed drawing correction filed on 27 August 2001 is a) ☐ approved or b) ☒ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 17.
10. ☐ Other: \_\_\_\_\_

EEC  
9/10/01

WILLIAM BRIGGS  
PRIMARY EXAMINER

Continuation of 2. NOTE: The proposed amendment raises new issues that would require further consideration and/or search. For example, the proposed amendment to claim 88 narrows the scope of that claim by changing "a positioner that relatively positions the tool support or a cable" to --a positioner that relatively positions the at least one tool support--. In other words, by eliminating the limitation "or a cable", the claim is narrowed in scope, which change in scope would require at least further consideration, and possibly would require further search.

The addition of the paragraph explaining new Figure 33 to the specification on page 36, before the last paragraph, constitutes new matter. Additionally, new Figure 33 constitutes new matter. Note that the specification as originally filed did not provide support for the degree of detail about the various tools set forth in the new paragraph and the new figure.

Additionally, the proposed drawing correction filed on 8/27/2001 has been disapproved because it is not in the form of a pen-and-ink sketch showing changes in red ink or with the changes otherwise highlighted. See MPEP § 608.02(v).

Regarding applicant's new declaration and applicant's assertions about the various priority claims set forth in the "Remarks" section of applicant's proposed amendment, pp. 42-43, it is noted that applicant's newly-filed declaration appears to be identical to the previous declaration, with the only difference being that it is newly executed. Thus, the previous objections to the declaration still apply. Additionally, it is noted that while applicant did file a certified copy of Swiss application 3235/95, filed 11/6/1995, that applicant has not properly requested the benefit of priority of this application, nor has applicant properly requested the benefit of the PCT/EP96/04790, nor perfected any such priority. Furthermore, applicant is now asserting that the present application is a continuation-in-part of PCT/EP97/05216. However, applicant has not met the conditions for filing a CIP. As previously set forth in the office action mailed 2/27/01, the present application was filed as a national stage application under 35 USC 371, and thus was not filed under 35 USC 111(a). Thus the claim for priority under 35 USC 120 is improper. For information on how to file a further application that is a proper CIP of the present national stage application, applicant's attention is directed to MPEP section 1895. Additionally, MPEP section 1896 sets forth the differences between a national application filed under 35 USC 111(a) and a national stage application filed under 35 USC 371.

The information disclosure statement filed 5/7/2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the IDS was filed after the mailing date of the final office action, and was not submitted with a certification under 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 C(1).